UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/545,381	04/07/2000	Craig Spielmann	JPM-001	2456

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EXAMINER
VAN DOREN, BETH .

ART UNIT	PAPER NUMBER
3623	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>10 June 2004</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-18</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-18</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   The following is a Final Office Action in response to communications received

06/10/2004. Claims 2-6, 8-14, 16, and 17 have been amended. Claims 1-18 are pending

in this application.

Claim Objections

2.   Claims 1, 10, and 14 are objected to because they each contain the limitation "the

control procedured identified by an administrator" which should more appropriately be --

the control procedures identified by an administrator--. Correction is required in each

instance.

3.   Claim 10 is also objected to because it contains steps a.-c., d., d., e.-i. (i.e. two

step d.'s are recited). Claim 10 should more appropriately recite steps a.-j. Correction is

required.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act

of 1999 (AIPA) do not apply to the examination of this application as the application

being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily

published under 35 U.S.C. 122(b). Therefore, this application is examined under 35

U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Higgins et al. (U.S. 6,397,202).

5.   As per claim 1, Higgins et al. teaches a method of managing risk with the aid of a computer system, said method comprising:

a.   the computer receiving a user selection of risk elements, said risk elements being retrieved from a database coupled to said computer (See at least figure 1, column 3, lines 30-45, column 4, lines 50-67, column 5, lines 1-15 and 27-50, wherein the user selects and manipulates risk elements stored in the database of the computer);

b.   for each risk element, the computer retrieving one or more predetermined control procedures, the control procedures identified by an administrator as a means for mitigating said risk element by reducing the likelihood that the risk will occur (See at least column 3, lines 27-45 and 57-67, column 4, lines 1-7 and 40-60, column 5, lines 1-15, column 6, lines 40-60, and column 7, lines 1-27, wherein control procedures that are programmed into the system by an expert and are related to the risk factor are identified, these control procedures being means to reduce the likelihood that a risk will occur);

c.   the computer associating said one or more predetermined control procedures with said risk element, said predetermined control procedures being stored in said database (See at least column 3, lines 27-45 and 57-67, column 4, lines 1-7 and 40-60, column 5, lines 1-15, column 6, lines 40-60, and column 7, lines 1-27, wherein the input risk elements are related to the control procedures);

     d.   the computer retrieving a weight assigned to each one of said

predetermined control procedures, said weight being stored in said database (See

at least column 3, lines 55-60, column 4, lines 1-7, column 5, lines 5-20, and

column 7, lines 1-20, which discusses weighting the control procedures);

     e.   the computer receiving a user selection of a compliance rating for each

said predetermined control procedure, the rating selected by the user indicating a

level of compliance with each one of said predetermined control procedures (See

at least column 3, lines 25-42 and 55-67, column 5, lines 4-20 and 45-60, column

6, lines 9-40, wherein the computer receives inputs from a user that rate the level

of compliance of the elements with the control procedure); and

     f.   the computer calculating a compliance score, each compliance score being

a function of said assigned weights and said compliance rating of said

predetermined control procedures (See at least figures 2 and 3 and column 3, lines

35-60, column 4, lines 1-15 and 42-67, column 5, lines 5-15, and column 7, lines

1-9 and 15-27, wherein the computer uses the expert system to calculate a score

which is a function of the weights and ratings supplied).

6.   As per claim 2, Higgins et al. teaches a method wherein said compliance ratings

comprise at least one rating identifying a non-fully compliant control procedure, said

method further comprising the steps of:

     a.   for each said control procedure having a non-fully compliant rating, the

computer receiving a user generated signal indicating whether said non-fully

compliant control procedure is accepted or not accepted (See at least column 4,

lines 1-15 and 65-67, column 5, lines 1-10, column 6, lines 1-25 and 60-67,

wherein the user generates a signal indicating that certain control procedures have

unacceptable compliance ratings); and

b.   for each of said non-fully compliant control procedure which is indicated

as not accepted, requiring the user to provide signals for generating an action plan

(See at least column 4, lines 1-15 and 65-67, column 5, lines 1-10, column 6, lines

1-25 and 60-67, wherein the user generates a signal changing inputs and weights

previously associated with a control procedures to create a new plan for

measurement).

7.   As per claim 3, Higgins et al. teaches a method wherein said action plan includes

a target date, said method further comprising the step of the computer calculating an

expected compliance score for one or more future dates based on said action plan target

dates (See at least figures 2 and 3 and column 3, lines 35-60, column 4, lines 1-15 and

42-67, column 5, lines 5-15 and 30-55 and column 7, lines 1-9 and 15-27, wherein the

computer uses the expert system to calculate a score for a future date which is a function

of weights, ratings, and dates).

8.   As per claim 4, Higgins et al. discloses a method further comprising the step of

the computer tracking whether said expected compliance scores have been met, said

tracking including calculating actual compliance scores for said target dates (See at least

figures 2 and 3, column 1, lines 15-20, column 3, lines 30-65, column 5, lines 35-55,

column 6, lines 60-67, wherein actual versus predicted are monitored).

9.   As per claim 5, Higgins et al. discloses a method further comprising the step of

the computer displaying said expected compliance scores versus said actual compliance

for the target dates (See figure 2 and column 5, lines 25-57, that teaches such a display).

10.   As per claim 6, Higgins et al. teaches a method further comprising the step of the computer associating one or more parameters with each said compliance rating (See at least column 3, lines 25-42 and 55-67, column 5, lines 4-20 and 45-60, column 6, lines 9-40, wherein the compliance rating is associated with parameters).

11.   As per claim 7, Higgins et al. teaches a method wherein said one or more parameters are selected from the group comprising organization, business line, process, and region (See column 3, lines 55-60, column 6, lines 10-40, which disclose organization parameters like staffing).

12.   As per claim 8, Higgins et al. teaches a method further comprising the step of the computer sorting said compliance scores by said one or more parameters (See at least figure 3, column 3, lines 30-60, column 4, lines 44-60, column 5, lines 15-22 and 40-67, column 6, lines 1-20, wherein values are input and stored and organized according to the parameter of risk to which the values are associated).

13.   As per claim 9, Higgins et al. discloses a method further comprising the step of the computer displaying said sorted compliance scores (See at least figures 2 and 3 and column 3, lines 30-55, which discloses a visual output).

14.   As per claim 10, Higgins et al. teaches a method of managing risk with the aid of a computer system, said method comprising:

   a.   the computer receiving a user selection of risk elements, said risk elements being retrieved from a database coupled to said computer (See at least figure 1, column 3, lines 30-45, column 4, lines 50-67, column 5, lines 1-15 and 27-50, wherein the user selects and manipulates risk elements stored in the database such as schedule risk);

b.   the computer identifying one or more subrisk elements associated with

each said risk elements, each subrisk element being retrieved from said database

(See at least figure 1, column 3, lines 30-60, column 4, lines 1-15 and 50-67,

column 5, lines 1-15 and 27-50, and column 6, lines 1-17, 20-35, and 49-54,

wherein the subrisk elements are associated with the risk, such as staffing levels

being associated with schedule risk);

c.   for at least one subrisk element, the computer retrieving one or more

predetermined control procedures, the control procedures identified by an

administrator as a means for mitigating said risk element by reducing the

likelihood that risk will occur (See at least column 3, lines 27-45 and 57-67,

column 4, lines 1-7 and 40-60, column 5, lines 1-15, column 6, lines 40-60, and

column 7, lines 1-27, wherein the input risk elements are related to the control

procedures);

d.   the computer associating said one or more control procedures with said

risk element, said control procedures being stored in said database (See at least

column 3, lines 27-45 and 57-67, column 4, lines 1-7 and 40-60, column 5, lines

1-15, column 6, lines 40-60, and column 7, lines 1-27);

e.   the computer retrieving a weight assigned to each one of said

predetermined control procedures, said weight being stored in said database (See

at least column 3, lines 55-60, column 4, lines 1-7, column 5, lines 5-20, and

column 7, lines 1-20, which discusses weighting the control procedures);

f.   the computer receiving a user selection of a compliance rating for each

said predetermined control procedure, said compliance ratings including a

plurality of categories including at least one category indicating said control

procedure is not fully compliant (See at least column 3, lines 25-42 and 55-67,

column 5, lines 4-20 and 45-60, column 6, lines 9-40, wherein the computer

receives inputs from a user that rate the level of compliance of the elements with

the control procedure);

g.   the computer calculating a compliance score, said compliance score being

a function of said assigned weights and said compliance rating of said control

procedures (See at least figures 2 and 3 and column 3, lines 35-60, column 4, lines

1-15 and 42-67, column 5, lines 5-15, and column 7, lines 1-9 and 15-27, wherein

the computer uses the expert system to calculate a score which is a function of the

weights and ratings supplied);

h.   for each subrisk, the computer determining whether at least one control

procedure associated with said subrisk is not fully compliant (See at least column

4, lines 1-15 and 65-67, column 5, lines 1-10, column 6, lines 1-25 and 60-67,

wherein the user generates the computer indicates that a subrisk is not compliant);

i.   for each subrisk associated with at least one control procedure which is not

fully compliant, the computer receiving a signal from the user indicating whether

said subrisk should be accepted or not accepted (See at least column 4, lines 1-15

and 65-67, column 5, lines 1-10, column 6, lines 1-25 and 60-67, wherein the user

generates a signal indicating that certain control procedures have unacceptable

compliance ratings); and

j.   for each subrisk which is indicated as not accepted, the computer

generating an action plan (See at least column 4, lines 1-15 and 65-67, column 5,

lines 1-10, column 6, lines 1-25 and 60-67, wherein the user generates a signal

changing inputs and weights previously associated with a control procedures to

create a new plan for measurement).

15.   As per claim 11, Higgins et al. teaches a method wherein said action plan further

includes a target date, said method further comprising the step of the computer

calculating a future compliance score based on said action plan target dates (See at least

figures 2 and 3 and column 3, lines 35-60, column 4, lines 1-15 and 42-67, column 5,

lines 5-15 and 30-55 and column 7, lines 1-9 and 15-27, wherein the computer uses the

expert system to calculate a score for a future date which is a function of dates).

16.   As per claims 12 and 13, claim 12 and 13 contain equivalent limitations to claims

6 and 8, respectively, and are therefore rejected using the art and rationale relied upon in

the rejection of claims 6 and 8, respectively.

17.   As per claim 14, Higgins et al. teaches a method of forecasting risk with the aid of

a computer system, said method comprising:

   a.   the computer identifying a set of risk elements, said risk elements being

   stored in a database coupled to said computer (See at least figure 1, column 3,

   lines 30-45, column 4, lines 50-67, column 5, lines 1-15 and 27-50, wherein the

   user selects and manipulates risk elements stored in the database of the computer);

   b.   for at least one risk element, the computer retrieving one or more

   predetermined control procedures, the control procedures identified by an

   administrator as a means for mitigating said risk element by reducing the

   likelihood the risk will occur (See at least column 3, lines 27-45 and 57-67,

   column 4, lines 1-7 and 40-60, column 5, lines 1-15, column 6, lines 40-60, and

column 7, lines 1-27, wherein control procedures that are programmed into the

system by an expert and are related to the risk factor are identified, these control

procedures being means to reduce the likelihood that a risk will occur);

c.   the computer associating said one or more control procedures with said

risk element, said control procedures being stored in said database (See at least

column 3, lines 27-45 and 57-67, column 4, lines 1-7 and 40-60, column 5, lines

1-15, column 6, lines 40-60, and column 7, lines 1-27, wherein the input risk

elements are related to the control procedures);

d.   the computer retrieving a weight assigned to each one of said

predetermined control procedures, said weight being stored in said database (See

at least column 3, lines 55-60, column 4, lines 1-7, column 5, lines 5-20, and

column 7, lines 1-20, which discusses weighting the control procedures);

e.   the computer receiving a user selection of a compliance rating for each

said predetermined control procedure, said compliance rating chosen from a set of

ratings including at least one rating identifying a non-fully compliant control

procedure and at least one rating identifying fully compliant control procedures

(See at least column 3, lines 25-42 and 55-67, column 5, lines 4-20 and 45-60,

column 6, lines 9-40, wherein the computer receives inputs from a user that rate

the level of compliance of the elements with the control procedure);

f.   for each said control procedure having a non-fully compliant rating, the

user employing the computer to generate an action plan, said action plan

including a target date for at least one action listed therein (See at least column 4,

lines 1-15 and 65-67, column 5, lines 1-10, column 6, lines 1-25 and 60-67,

wherein the user generates a signal changing inputs and weights previously

associated with a control procedures to create a new plan for measurement); and

g.   the computer calculating an expected compliance score for a future date,

said expected compliance score being a function of said assigned weights, said

fully compliant control procedures, and said action plan target dates for said non-

fully complaint control procedures (See at least figures 2 and 3 and column 3,

lines 35-60, column 4, lines 1-15 and 42-67, column 5, lines 5-15 and 30-55 and

column 7, lines 1-9 and 15-27, wherein the computer uses the expert system to

calculate a score for a future date which is a function of weights, ratings, and

dates).

18.   As per claim 15, Higgins et al. teaches a method wherein said action plan

comprises a signal indicating whether said non-fully compliant rating is accepted or not

accepted, said expected compliance score further being a function of said non-fully

compliant ratings which have been accepted (See at least column 4, lines 1-15 and 65-67,

column 5, lines 1-10, column 6, lines 1-25 and 60-67, wherein the user generates a signal

indicating that certain control procedures have unacceptable compliance ratings).

18.   As per claim 16, Higgins et al. teaches a data processing system for managing

risk, said system comprising

a.   a database (See at least figure 1, column 3, lines 30-45, column 4, lines

50-67, column 5, lines 1-15 and 27-50, wherein a database is discloed);

b.   a processor coupled to said database, said processor being programmed to

perform the steps comprising (See at least figure 1, column 4, lines 40-60, column

5, lines 35-55):

i.   the computer receiving a first signal identifying a user selection of

a set of risk elements, said risk elements being stored in said database (See

at least figure 1, column 3, lines 30-45, column 4, lines 50-67, column 5,

lines 1-15 and 27-50, wherein the user selects and manipulates risk

elements stored in the database of the computer);

ii.   the computer receiving a second signal identifying a user selection

of one or more control procedures associated with each said risk element,

said control procedure comprising a means to mitigate said risk element,

said control procedure being stored in said database (See at least column

3, lines 27-45 and 57-67, column 4, lines 1-7 and 40-60, column 5, lines 1-

15, column 6, lines 40-60, and column 7, lines 1-27, wherein control

procedures that are programmed into the system by an expert and are

related to the risk factor are identified, these control procedures being

means to reduce the likelihood that a risk will occur);

iii.   the computer receiving a third signal assigning a weight to each

said control procedure, said weight being stored in said database (See at

least column 3, lines 55-60, column 4, lines 1-7, column 5, lines 5-20, and

column 7, lines 1-20, discussing weighting the control procedures); and

v.   the computer calculating a compliance score, said compliance

score being a function of said assigned weights and said compliance rating

of said control procedures (See at least figures 2 and 3 and column 3, lines

35-60, column 4, lines 1-15 and 42-67, column 5, lines 5-15 and 30-55

and column 7, lines 1-9 and 15-27, wherein the computer uses the expert

system to calculate a score which is a function of weights and ratings).

19.   As per claim 17, Higgins et al. teaches a data processing system wherein said

compliance ratings comprise at least one rating identifying a non-fully compliant control

procedure, said processor being further programmed to perform the steps comprising:

a.   for each said control procedure having a non-fully compliant rating, the

computer receiving a signal indicating whether said non-fully compliant rating is

accepted or not accepted (See at least column 4, lines 1-15 and 65-67, column 5,

lines 1-10, column 6, lines 1-25 and 60-67, wherein the user generates a signal

indicating that certain control procedures have unacceptable compliance ratings);

b.   for each said non-fully compliant control procedure which is indicated as

not accepted, the computer receiving an action plan, said action plan including an

expected target date for implementation and an expected compliance rating (See

at least column 4, lines 1-15 and 65-67, column 5, lines 1-10, column 6, lines 1-25

and 60-67, wherein the user generates a signal changing inputs and weights

previously associated with a control procedures to create a new plan for

measurement); and

c.   the computer generating one or more future expected compliance scores,

said compliance scores being a function of said target dates, said assigned

weights, and said expected compliance rating of said control procedures (See at

least column 5, lines 25-55, and column 7, lines 20-30, wherein future scores are

determined).

20.   As per claim 18, Higgins et al. teaches a data processing system further

comprising a computer display coupled to said processor, said processor further being

programmed to display said compliance scores on a computer display (See at least figures

2 and 3 and column 3, lines 30-55, which discloses a visual output).

Response to Arguments

21.   Applicant's arguments with respect to claims 1-18 have been considered but are

moot in view of the new grounds of rejection, as necessitated by amendment.

Conclusion

Applicant's amendment necessitated the new grounds of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

advisory action. In no event, however, will the statutory period for reply expire later than

SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Beth Van Doren whose telephone number is (703) 305-

3882. The examiner can normally be reached on M-F, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Tariq Hafiz can be reached on (703) 305-9643. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

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Center (EBC) at 866-217-9197 (toll-free).

bvd
September 3, 2004

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